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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,482

03/20/2006

Austen Peter Bradley

120708-158710

4044

24964

7590

01/07/2009

GOODWIN PROCTER LLP

ATTN: PATENT ADMINISTRATOR

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EXAMINER

BLIZZARD, CHRISTOPHER JAMES

ART UNIT

PAPER NUMBER

4185

MAIL DATE

DELIVERY MODE

01/07/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,482

Applicant(s)

BRADLEY, AUSTEN PETER

Examiner

CHRISTOPHER BLIZZARD

Art Unit

4185

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-850)
Paper No(s)/Mail Date 4/29/2005
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19, 1, 20-35, respectively, of U.S. Patent No. 7,211,049 in view of Mault (US 6,478,736).

Although the claims are not identical, they are not patentably distinct from one another. The application claims are broader in at least one aspect and also recite additional features not claimed in the patent claims.

Regarding the broadening aspect of the application claims, the following comparison between the patent claims and the application claims highlights what elements have been excluded in the presentation of the application claims.

Patent claim 1	Application claim 1
A breath monitoring device comprising; means to record a first breathing state of a user; means to detect a deviation from the recorded breathing state in a subsequent use of the device by a user; <u>and means for accepting or declining a breath recordal by a user, whether a breath is within the parameters of the first breathing state or is a deviation from the first breathing state.</u>	A breath monitoring device in the form of a calorimeter comprising means to record a first breathing state of calories expended by a user, and means to detect a deviation from the recorded breathing state in a subsequent use of the device by a user.

Patent claim 25	Application claim 26
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<p>A method of monitoring breaths, the method comprising the steps of:</p> <p>(a) recording the first breathing state of a person from a breath of a person;</p> <p>(b) detecting a deviation from the recorded first breathing state in a subsequent breath from a person, and</p> <p><u>(c) allowing a user to accept or decline a breath recordal, dependent on whether a breath is within parameters of the first breathing state or is a deviation from the first breathing state.</u></p>	<p>A method of monitoring breaths, the method comprising the steps of:</p> <p>(a) recording the first breathing state of calories expended by a person from a breath of a person; and</p> <p>(b) detecting a deviation from the recorded first breathing state in a subsequent breath from a person, and</p>
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Thus, it is apparent that the more specific patent claims 1 and 25 encompass application claims 1 and 26, respectively. Following the rationale in *In re Goodman*, cited above, where applicant has once been granted a patent containing a claim for the specific or narrower invention, applicant may not then obtain a second patent with a claim for the generic or broader invention without first submitting an appropriate terminal disclaimer. Note that since application claims 1 and 26 are anticipated by patent claims 1 and 25, respectively, and since anticipation is the epitome of obviousness, then application claims 1 and 26 are obvious over patent claims 1 and 25, respectively.

With respect to the additional features recited in the application claims, the inclusion of the calorimeter and method of recording the first breathing state of calories expended by a person is an obvious improvement in view of Mault. Mault teaches a breath monitoring device in the form of a calorimeter capable of recording the first breathing state of calories expended by a person (column 3, lines 20-30). Since the

patent claims recite a breath monitoring device and Mault teaches a similar breath monitoring device with the use of a calorimeter it would have been obvious to one of ordinary skill in the art to modify breath monitoring device and method in the patent claims to include a calorimeter and method of recording the first breathing state of calories expended by a person.

With respect to claims 2-36 these claims are substantially identical to patent claims 2-19, 1, and 20-35.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-15 and 20-36** are rejected under 35 U.S.C. 102(b) as being anticipate by **Mault (US 6,478,736 B1)**.

3. **Regarding claim 1**, Mault discloses a breath monitoring device in the form of a calorimeter (10) comprising means to record a first breathing state of calories expended by a user (column 3, lines 51-55), and means to detect a deviation from the recorded breathing state in a subsequent use of the device by a user (column 3, lines 59-61).

4. **Regarding claim 2**, Mault discloses a breath monitoring device comprising a housing (12) in which the recording means and detection means are located (column 6, lines 26-29).

5. **Regarding claim 3**, Mault discloses a breath monitoring device wherein the means to record a first breathing state of the user comprises means to record at least one further breath parameter of a user in addition to calories expended (column 5, lines 2-4).

6. **Regarding claim 4**, Mault discloses a breath monitoring device wherein the breath parameter is selected from inhalation speed, exhalation speed, inhalation volume, exhalation volume, oxygen content of exhaled breath, carbon dioxide content of exhaled breath, time interval between breaths, number of breaths in a predetermined time period, duration of an exhalation, duration of an inhalation and the rate of change of any of the aforementioned parameters (column 5, lines 32-34).

7. **Regarding claim 5**, Mault discloses a breath monitoring device wherein the means to record a first breathing state of a user is one or more means selected from an inhalation speed sensor, an exhalation speed sensor, an inhalation volume sensor, an exhalation volume sensor, an inhalation duration sensor, an exhalation duration sensor, an inhalation pressure sensor and an exhalation pressure sensor (column 5, lines 27-34).

8. **Regarding claim 6**, Mault discloses a breath monitoring device wherein the means to record a first breathing state of a user comprises means to record an unforced breathing state (columns 4 and 5; lines 67 and 1).

9. **Regarding claim 7**, Mault discloses a breath monitoring device wherein the unforced breathing state is a resting breathing state or the breathing state of the user after physical activity or exertion (Abstract).

10. **Regarding claim 8**, Mault discloses a breath monitoring device as wherein the means to detect a deviation from the first breathing state comprises the means to record the first breathing state (column 3, lines 20-30).
11. **Regarding claim 9**, Mault discloses a breath monitoring device wherein the means to detect a deviation from the first breathing state comprises means to detect when a user other than the first user uses the device (column 7, lines 3-6).
12. **Regarding claim 10**, Mault discloses a breath monitoring device wherein the device further comprises means to store data obtained from the first breathing state recordal means (column 6, lines 26-29).
13. **Regarding claim 11**, Mault discloses a breath monitoring device wherein the data storage means comprises a machine readable medium, on which data may be stored by any suitable means (column 6, lines 21-30).
14. **Regarding claim 12**, Mault discloses a breath monitoring device wherein the data storage means comprises a computer hard disk, chip-based memory, floppy disk, compact disc, DVD (digital versatile disc), or mini-disc (column 6, 26-27).
15. **Regarding claim 13**, Mault discloses a breath monitoring device wherein the device further comprises indicating means, arranged to indicate when a deviation from the first breathing state is detected by the deviation detection means (column 11, lines 36-45).
16. **Regarding claim 14**, Mault discloses a breath monitoring device wherein the indicating means is a visual indicating means, audio indicator means, or both visual and audio indicator means (column 11, lines 46-57).

17. **Regarding claim 15**, Mault discloses a breath monitoring device wherein the indicating means is capable of displaying the extent of the deviation of the or each breath parameter which does not conform to the or each breath parameter of the first breathing state (fig. 12c).

18. **Regarding claim 20**, Mault discloses a breath monitoring device comprising means for a user to accept or decline a breath recordal, whether a breath is within the parameters of the first breathing state or is a deviation from the first breathing state, by means of revising goals (fig. 6) after a breath recordal and proceeding to complete another breath recordal.

19. **Regarding claim 21**, Mault discloses a breath monitoring device wherein the breath recordal acceptance means comprises a switch, in the form of the "Revise Goals?" option (fig. 6), which in use must be activated to accept a breath reading in order for the reading to be recorded by the means to record the first breathing state of a user.

20. **Regarding claim 22**, Mault discloses a breath monitoring device comprising a fluid inlet (30), which in use is arranged to allow passage of a users breath into and out of the device (column 5, lines 17-18).

21. **Regarding claim 23**, Mault discloses a breath monitoring device wherein the fluid inlet comprises a mouthpiece (column 5, lines 42-44).

22. **Regarding claim 24**, Mault discloses a breath monitoring device wherein the mouthpiece is detachably connected to the fluid inlet (column 13, lines 5-7).

23. **Regarding claim 25**, Mault discloses a breath monitoring device wherein the mouthpiece comprises a mask (14) arranged in use to be placed over at least the mouth of a user (fig. 18).

24. **Regarding claim 26**, Mault discloses a method of monitoring breaths, the method comprising the steps of: recording the first breathing state of calories expended by a person, from a breath of a person; and detecting a deviation from the recorded first breathing state in a subsequent breath from a person (column 3; lines 10-13, 26-30).

25. **Regarding claim 27**, Mault discloses a method wherein recording the first breathing state of calories expended by a person comprises recording a first breathing state determined from a plurality of breaths from the person (columns 4 and 5; lines 67 and 1-2).

26. **Regarding claim 28**, Mault discloses a method wherein recording the first breathing state of calories expended by a person comprises monitoring at least one breath parameter of the persons breath (column 5, lines 1-4).

27. **Regard claim 29**, Mault discloses a method wherein the breath parameter is at least one parameter selected from inhalation speed, exhalation speed, inhalation volume, exhalation volume, oxygen content of exhaled breath, carbon dioxide content of exhaled breath, time interval between breaths, number of breaths in a predetermined time period, duration of an exhalation, duration of an inhalation and the rate of change of any of the aforementioned parameters (column 5, line 4).

28. **Regarding claim 30**, Mault discloses a method wherein detecting a deviation from the recorded first breathing state in a subsequent breath from a person comprises

comparing one or more subsequent breaths of a person with the first breathing state recorded from the or each breath recorded for the first breathing state (column 3, lines 31-35)

29. **Regarding claim 31**, Mault discloses a method wherein there is a step between recording the first breathing state and detecting a deviation from the recorded first breathing state, of storing data obtained from the recordal of the first breathing state of the person (column 3, lines 51-61) (fig. 6).

30. **Regarding claim 32**, Mault discloses a method wherein detecting a deviation from the recorded first breathing state in a subsequent breath from a person comprises detecting a deviation from the stored data (column 3, lines 34-35).

31. **Regarding claim 33**, Mault discloses a method wherein detecting a deviation from the recorded first breathing state in a subsequent breath from a person may comprise detecting a deviation from a subsequent breath or breaths originating from the same person as recording the first breathing state of calories expended by a person, from a breath of a person, or from a different person (column 3, lines 34-35).

32. **Regarding claim 34**, Mault discloses a method wherein the method comprises distinguishing between a first breathing state of a first person and a breathing state of a second person (column 7, lines 5-6).

33. **Regarding claim 35**, Mault discloses a step of indicating when a deviation has been detected, in the form of "view current balance/trends" (fig. 6).

34. **Regarding claim 36**, Mault discloses a method of monitoring breaths as claimed in claim 26, using a breath monitoring device as claimed in claim 1 (column 3, lines 20-35).

Claim Rejections - 35 USC § 103

35. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

36. **Claim 16-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mault (US 6,478,736 B1)** in view of **Greene (US 6,454,724 B1)**.

37. **Regarding claim 16**, Mault fails to disclose a breath monitoring device comprising means to temporarily prevent operation of the device by a user, when a deviation from the first breathing state is detected.

However, Green teaches a breath monitoring device comprising a means to temporarily prevent operation of the device by a user when a deviation from the first breathing state is detected (column 3 lines 47-53).

38. It would have been obvious to one of ordinary skill in the art to modify the invention of Mault to include a means to temporarily prevent operation of the device as taught by Greene since doing so would allow the device to still be operable after an error in operation occurs.

39. **Regarding claim 17**, Mault fails to disclose a breath monitoring device wherein the device operation prevention means prevents operation for a defined time period.

However, Green teaches a breath monitoring device wherein the device operation prevention means prevents operation for a defined time period, the time period being defined by the method step (31) of deactivating the system and cycling back to step (20) which causes the system to cycle through a time delay circuit (column 3, line 21) before the alarm is armed again making the device operable.

40. It would have been obvious to one of ordinary skill in the art to modify the invention of Mault to include a means to temporarily prevent operation of the device with a defined time period as taught by Greene since doing so would allow the user to determine the reason for deviation before reusing the device.

41. Regarding claim 18, Mault fails to disclose a breath monitoring device wherein the device operation prevention means comprises a switch or trigger which is activated when the deviation detection means detects a deviation from the first breathing state.

However, Green teaches a breath monitoring device wherein the device operation prevention means comprises a switch or trigger which is activated when the deviation detection means detects a deviation from the first breathing state (column 3, lines 47-49).

42. It would have been obvious to one of ordinary skill in the art to modify the invention of Mault to include a means to temporarily prevent operation of the device with a switch or trigger as taught by Greene since doing so would allow the user to have better control of the device functions when a deviation occurs.

43. **Regarding claim 19**, Mault fails to disclose a breath monitoring device wherein the device operation prevention means prevents subsequent breaths by a user from entering the device, or prevents recordal of subsequent breaths by the recordal means.

However, Greene teaches a breath monitoring device wherein the device operation prevention means allows the user to leave the device and return to it without recordal of subsequent breaths, since the user is not present with the device (column 3, lines 53-60).

44. It would have been obvious to one of ordinary skill in the art to modify the invention of Mault to include a means to temporarily prevent operation of the device as taught by Greene since doing so would prevent the device from taking in accurate readings from the user.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Blizzard whose telephone number is (571)-270-7138. The examiner can normally be reached on Monday-Thursday 7:30 AM - 6:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrell McKinnon can be reached on (571) 272-4797.

12/24/08
/C. B./
Examiner, Art Unit 4185

/Edward K. Look/
Supervisory Patent Examiner, Art Unit 3745

